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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,554	10/31/2003	Karl Johnson	081776-0306363	8401
909	7590	10/03/2005	EXAMINER	
PILLSBURY WINTHROP SHAW PITTMAN, LLP			NGUYEN, PHONG H	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			3724	

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/697,554

Applicant(s)

JOHNSON ET AL.

Examiner

Phong H. Nguyen

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 26-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14-20, 23 and 25 is/are rejected.
- 7) ☒ Claim(s) 12, 13, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/03/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of claims 1-23 and 25 in the reply filed on 07/27/2005 is acknowledged. The traversal is on the ground(s) that there is no burden on the Examiner to examine all the claims. This is not found persuasive because there is a serious burden on the Examiner to examine all the claims.

The requirement is still deemed proper and is therefore made FINAL.

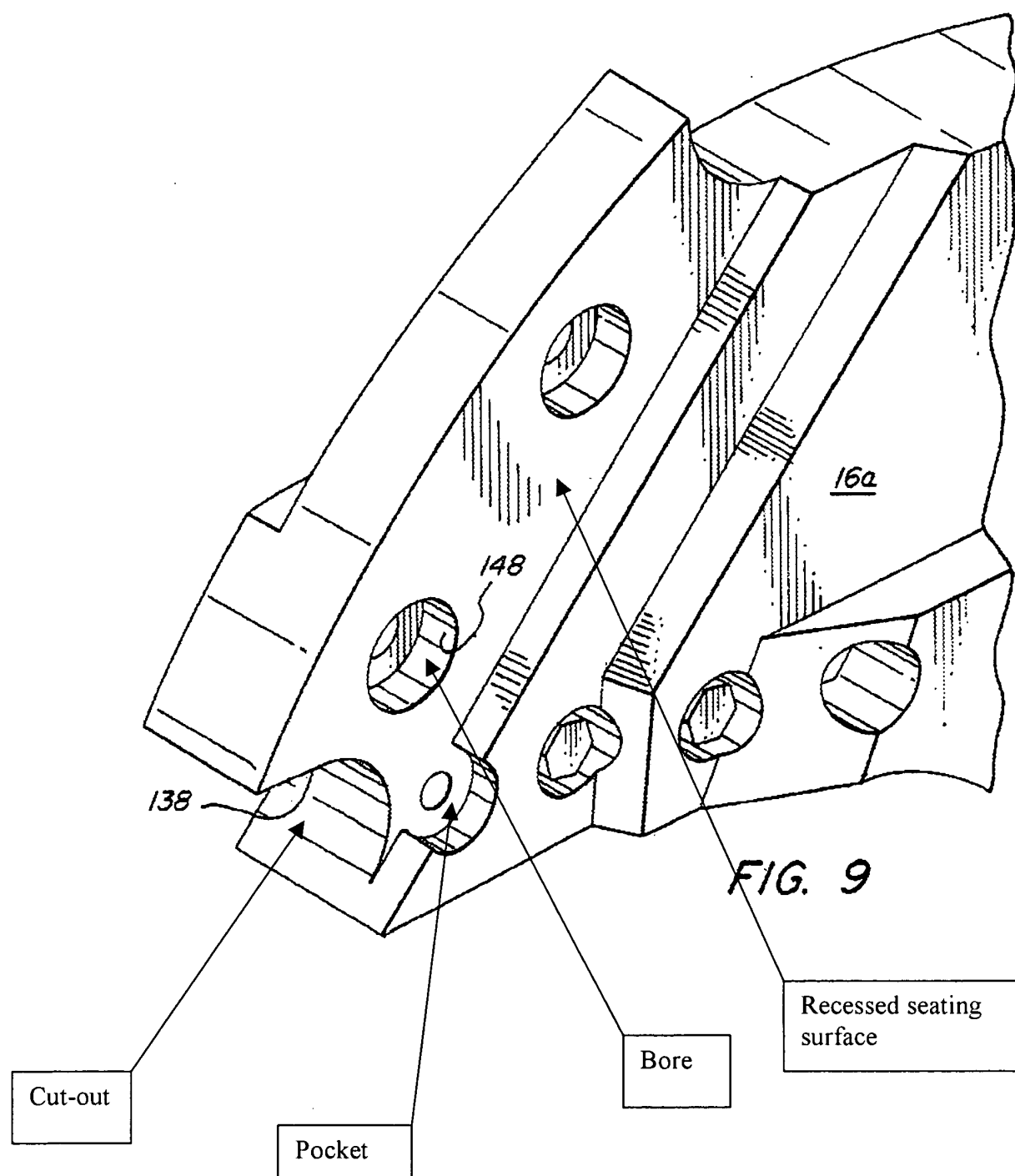
Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 23 and 25 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Sederberg et al. (5,992,023), hereinafter, Sederberg. See Fig. 9.



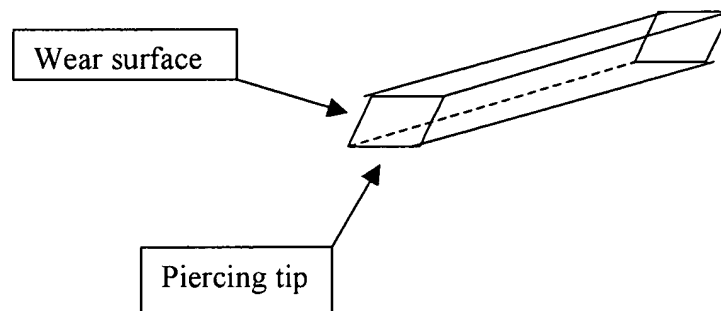
Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-11 and 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morikawa (5,339,525) in view of Sederberg.

Regarding claims 1-4, Morikawa teaches a wearing plate/piercing tip 7. See Figs. 1-5 and the below sketch.



Morikawa fails to teach the geometric configuration of the wear plate/pierce tip being the same in a first position and a second position, wherein the second position is a position in which the wear plate/tip insert is rotated 180 degrees. Sederberg teaches the geometric configuration of the wear plate/pierce tip 116 being the same in the first position and the second position. See Fig. 13 and 14. Therefore, it would have been obvious to one skilled in the art to provide the wear plate/pierce tip of Morikawa the

geometric configuration as taught in Sederberg so that both sides of the wear plate/pierce tip can be used to reduce the spare part of the wear plate/pierce tip.

Regarding claims 5-9 and 14-18, Morikawa teaches a shears comprising a fixed jaw having a first cutting edge 10, a movable jaw having a second cutting edge 8, an indexable wear plate/pierce tip 7. See Figs. 1-5.

Morikawa fails to teach the geometric configuration of the wear plate/pierce tip being the same in a first position and a second position, wherein the second position is a position in which the wear plate/tip insert is rotated 180 degrees. Sederberg teaches the geometric configuration of the wear plate/pierce tip 116 being the same in the first position and the second position. See Fig. 13 and 14. Therefore, it would have been obvious to one skilled in the art to provide the wear plate/pierce tip of Morikawa the geometric configuration as taught in Sederberg so that both sides of the wear plate/pierce tip can be used to reduce the spare part of the wear plate/pierce tip.

Regarding claim 10 and 19, Morikawa teaches the invention substantially as claimed except for providing a boss on the wear plate/pierce tip and a depression on the movable jaw for receiving the boss. Sederberg teaches providing a boss 150 on the wear plate/pierce tip and a depression 148 on the movable jaw for receiving the boss. Therefore, it would have been obvious to one skilled in the art to provide providing a boss on the wear plate/pierce tip and a depression on the movable jaw for receiving the boss in the shears assembly of Morikawa for quicker alignment the wear plate/pierce tip to the movable jaw.

Regarding claims 11 and 20, the first cutting edge 10 and the second cutting edge 8 are best seen in Figs. 1-5.

Allowable Subject Matter

6. Claims 12, 13, 21 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H. Nguyen whose telephone number is 571-272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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PN:

A handwritten signature in black ink, appearing to be a stylized 'M' or 'W' followed by a long horizontal stroke.

September 27, 2005

A handwritten signature in black ink, appearing to be 'ay' followed by a long diagonal stroke.

Allan N. Shoap
Supervisory Patent Examiner
Group 3700